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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,038	02/02/2004	Eiichi Okutsu	FS-F03226-01	7584
37398	7590	12/28/2005	EXAMINER	
TAIYO CORPORATION 401 HOLLAND LANE #407 ALEXANDRIA, VA 22314			CHEMA, THORL	
		ART UNIT		PAPER NUMBER
				1752

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/768,038	OKUTSU ET AL.
	Examiner	Art Unit
	Thorl Chea	1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 14 October 2005.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1 and 3-20 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1 and 3-20 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

1. This second office action is responsive to the communication on October 14, 2005; claims 1, 3-20 are pending in this instant application; claim 2 has been canceled.
2. The rejection set forth in previous office action, paragraph 3 is withdrawn in view of the amendment on October 14, 2004.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 3-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 is unclear with respect to “the distance between a scanning line of the laser irradiation means and an inserting portion of the thermal development unit” since the scanning line during exposure and the position thereof cannot be determined and therefore, the distance between the line and the thermal development using is changing. Also, the specification fails to clearly show the line of the laser, but the scanning exposure position (18). It is suggested to use the distance between scanning exposure position of the photothermographic material and an inserting portion of the thermal development unit, rather than “distance between a scanning line of the laser irradiation means and an inserting portion of the thermal development unit”. Claims 5-10 is unclear with respect to the antecedent basis for the term “the thermal development”. Claim 1 contains the term “thermal development unit”, rather than “thermal development”.

Claim 11 is unclear with respect to the “the thermal development”, and the step of “using” an image recording apparatus comprising a laser irradiating means and a thermal developing mean” is indefinite since the “using” is clearly defined the actual performing step of forming an image.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Morita et al (US 2003/0215756) and Oya et al (U.S. Patent 6,376,166).

Morita et al disclose a photothermographic material containing a composition of two bisphenol compounds, the bisphenol of formula A-1 and the bisphenol of formula A-2. The bisphenol A-2 is within the scope of formula (R1) of the claimed invention. See exemplified samples on pages 18-23, compound I-18 to I-65. The compound of formula A-1 differs from the compound of formula (R2), X in the formula (A-1) is a chalcogen or CHR, wherein R is a hydrogen or an alkyl group. The material is process within a period of 1 sec. to 2 mn at a temperature of 80 °C to 200 °C. See page 42, [0352], [0353]; see also the apparatus of Fig 1 and the description thereof on page 42, [0350] having exposure portion (120) and developing section 130; the laser scanning exposure in column 41, [0338] to [0348]; and the silver coverage from 0.3 to 1.5 g/m<sup>2</sup> on page 30, [0329].

Oya et al discloses a bisphenols compound having formula within the scope of formula R2 of the claimed invention. See column 2, formula (1) and the definition of -CH(V<sup>9</sup>)- in column 7,

lines 53-62 wherein V<sup>9</sup> particularly preferred as an alkyl group and alkenyl group. Therefore, the bisphenols compound having an bridging group of the bisphenols compound having an alkyl group and alkenyl group are equivalent, and the use thereof in the material of Morita et al would have been obvious to the worker of ordinary skill in the art at the time the invention was made. Moreover, the apparatus taught in Morita et al contains a laser irradiating mean and a thermal developing mean, and the material is developed at temperature preferably 100 to 200 °C over period of time from 1 second to 2 min at the transfer speed of 20 to 200 mm/second in column 42, [0351] to [0352]. The thermal development, with an interval of time equal or less than 12 second claimed in the present invention overlaps the interval of time between 1 second to 2 min taught in Morita et al. It would obvious to the worker of ordinary skill in the art at the time the invention was made to carry out the development process of the material obtained by the combination of Morita et al and Oya et al within the interval taught in Morita et al with an expectation of forming an image.

*Response to Arguments*

7. Applicant's arguments filed s 11-20 are have been fully considered but they are not persuasive because of the reason set forth above. The interval of time of developing claimed in the present invention overlaps the time claimed in the present claimed invention. The worker of ordinary skill in the art would have adjusted heating time, heating temperature in combination the transfer speed of the photothermographic material to provide the speed of development claimed in the present claimed invention.

The applicants argue that "the interval time in the present invention means a time from a separation of the photosensitive material from the a heater of the thermal development unit to

contact of a next photo of a next photosensitive as disclosed on page p.165, lines 9-25 to p. 166, lines 1-18 of applicants specification”.

The argument is not persuasive since such limitation is not presented in the claims and the limitation disclosed in the specification disclosure cannot be read into the claims.

8. Kudo (US 2004/0005521), Oyamada et al (US 2004/0038156) and Yamane (US Patent No. 6,800,427) are withdrawn as prior art in view of the English translation of the foreign priority document provided on November 2, 2005.

9. Claims 1, 3-10 would be allowable if amended to overcome the rejection under 35 USC 112 set forth in the paragraph above.

*Conclusion*

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The amendment of claim 11 raises the issue under 35 USC 112, second paragraph.

Therefore, the amendment initiates new ground of rejection.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Thorl Chea*  
Thorl Chea  
Primary Examiner  
Art Unit 1752

Tch *th*  
December 21, 2005